

**REMARKS**

**Specification**

The specification has been amended as needed, to comply with Office requirements.

**Claim Objections**

Relevant claim portion has been amended, as needed, to overcome this objection.

Reconsideration and withdrawal of this objection are respectfully requested.

**Claim Rejections under 35 USC §103**

**Claims 1-3 and 8 are rejected under 35 USC §103(a) as being unpatentable over Miyake (U.S. Patent No. 5,767,904) in view of Horii (U.S. Patent No. 6,018,363).**

Independent claim 1 is supported by way of an example in Figure 1 and associated written description of the present application, wherein there is indeed shown a digital camera for performing continuous shots of a subject with different exposures, comprising: a signal generator 16 for generating a timing signal (arrow from SG to TG); a first register 15a for holding exposure data; a timing generator 14 for causing exposure according to exposure data held in said first register 15a in response to said timing signal (arrow from SG to TG); an instruction key 58 for instructing for a continuous shot operation; and a processor 46 for starting to count said timing signal (arrow from SG to TG) in response to an instruction of said instruction key 58, and performing an update process to update said exposure data held in said first register 15a in first predetermined timing.

In rejecting the claimed invention, the outstanding Office action has specifically stated that "Miyake fails to specifically disclose a signal generator for generating a timing signal.

The Applicant agrees with this Office assessed shortcoming of Miyake.

Given that the Office admits Miyake fails to disclose a signal generator for generating a timing signal, naturally, Miyake also fails to disclose or teach a timing generator for causing exposure according to exposure data held in said first register in response to said timing signal; and a processor for starting to count said timing signal in response to an instruction of said instruction key, and performing an update process to update said exposure data held in said first register in first predetermined timing.

Even though the Office attempts to supplement the shortcoming of Miyake by asserting a secondary reference Horii citing the existence of a timing generator 112 and associated written description in column 10 between lines 1-19, there is still no disclosure or teaching of a timing generator for causing exposure according to exposure data held in said first register in response to said timing signal; and a processor for starting to count said timing signal in response to an instruction of said instruction key, and performing an update process to update said exposure data held in said first register in first predetermined timing. Therefore, the combination rejection fails to render the claimed invention obvious.

Section 706.01(j) of the MPEP has specifically stated that:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be

a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 466, 20 USPQ2d 1438 (Fed. Cir. 1991)."

Therefore, it is both a court position and a Patent Office position that to establish a *prima facie* case of obviousness, 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Therefore, should the Office either be unable to identify each and every aspect of the above-mentioned claimed features after taking full consideration of the asserted prior art in a way exactly applied in the outstanding Office action, or the Office recognizes that the rejection simply does not arise to a level objectively fulfilling all three criteria of establishing a *prima facie* case of obviousness, it is respectfully submitted that the obviousness rejection is defective and allowance of the claimed invention is requested.

**Allowable Subject Matter:**

The indication of allowable subject matter in claims 4-7 is noted with appreciation.

**Prior Art Indicated To Be Pertinent To The Disclosure:**

The Office has provided a list of prior art indicated to be pertinent to the Applicant's invention. Consistent with the understanding as stipulated in MPEP 706.02 that only the best prior art should be applied, this list of prior art not having been applied by the Office, it is the Applicant's understanding that the Office must have considered the listed prior art to be no more pertinent than the applied prior art of record.

**New Claims:**

A family of claims 9-12 is added herein by Amendment.

According to claim 9, a timing signal is periodically generated by a signal generator, and exposure data is held in a first register. A timing generator periodically causes exposure according to the exposure data held in the first register, in response to the timing signal. Furthermore, a processor updates the exposure data held in the first register, at first predetermined timing by counting the timing signal. Consequently, a subject is continuously shot with different exposures.

In contrast, Miyake discloses a continuous picture-taking mode for continuously taking a picture of a subject, while Miyake fails to disclose or remotely suggest anything about updating exposure data at every time a picture is taken. Therefore, it is not possible to reach claim 9 from

Miyake.

Horii discloses a synchronous signal generator for generating a timing signal, while Horii fails to disclose or remotely suggest anything about such an operation as continuously shooting a subject with different exposures. Accordingly, it is not possible to reach claim 9 from Horii.

Regarding a combination of Miyake and Horii, no references disclose or remotely suggest anything about continuously shooting a subject with different exposures. Accordingly, even if Miyake and Horii can be combined, it is not possible to reach claim 9 from the combination, and therefore, the claims 9 is patentable.

**CONCLUSION**

In view of the aforementioned amendments and accompanying remarks, all pending claims are believed to be in condition for allowance, which action, at an early date, is requested.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 50-2866.

Respectfully Submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



Michael N. Lau  
Attorney for Applicant  
Reg. No. 39,479

MNL/eg/asc  
Atty. Docket No. 991206  
Suite 700,  
1250 Connecticut Ave., N.W.  
Washington, D.C. 20036  
(202) 822-1100

38834  
PATENT TRADEMARK OFFICE